



UNITED STATES PATENT AND TRADEMARK OFFICE

CH
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,571	09/23/2005	Jordi Tormo i Blasco	5000-0134PUS1	1311

2292 7590 02/16/2007
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

LEESER, ERICH A

ART UNIT	PAPER NUMBER
----------	--------------

1624

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	02/16/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/16/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/550,571

Applicant(s)

BLASCO ET AL.

Examiner

Erich A. Leeser

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-8 are currently pending.

Claim Objections

2. Applicant has amended claim 6 to overcome Examiner's previous rejection of this claim based on improper multiple dependency. Examiner's objection to claim 6; however, is maintained on different grounds because claim 6 depends from a rejected base claim, in this case claim 1.

Claim Rejections – 35 U.S.C. § 112

3. Examiner's previous rejection of claims 1-5 is withdrawn because Applicant's amendment of these claims have effectively obviated the rejections.

Claim Rejections 35 U.S.C. § 103

4. Examiner previously rejected claims 1 and 3-5 and 7-8 under 35 U.S.C. § 103(a) as being unpatentable over Pees et al., U.S. 5,965,561.
5. Applicant argues that: "It is well settled that a genus does not always *anticipate* a claim to a species within the genus." (Emphasis added). It is important to note that this rejection is *not* an anticipation rejection, had Examiner found an exemplified compound in Pees et al., '561, then Examiner would have made a 102 rejection instead of the present 103 rejection.
6. Applicant then goes on to argue that: "Pees '561 discloses preferred embodiments, none of which lists alkynyl as a preferred R¹ or R² group." This is simply not true because Pees et al., '561 expressly suggests alkynyl in their preferred embodiments at line 46, column 3.

Art Unit: 1624

7. Finally, Applicant argues that: "Pees '561 is absolutely silent about *Puccinia Recondita*."

This argument is irrelevant to any issues of patentability because activity against *Puccinia Recondita* is not a claim limitation of any of the claims of the instant invention.

8. Because Examiner does not find any of Applicant's arguments persuasive, his previous rejection of claims 1 and 3-5 and 7-8 under 35 U.S.C. § 103(a) as being unpatentable over Pees et al., U.S. 5,965,561 is made FINAL.

9. Examiner previously provisionally rejected claims 2-4 under 35 U.S.C. § 103(a) as being unpatentable over Blasco et al., U.S. Application Number 10/474,460. Examiner acknowledges that Blasco et al., U.S. Application Number 10/474,460 has matured in to U.S. Patent No. 7,105,664.

10. Applicant argues that: "a compound is *anticipated* only when one of ordinary skill in the art is able to 'at once envisage' the specific compound within the generic chemical formula." (Emphasis added). It is important to note that this rejection is *not* an anticipation rejection, had Examiner found an exemplified compound in Blasco et al., '664, then Examiner would have made a 102 rejection instead of the present 103 rejection.

11. Applicant then goes on to argue that: "Blasco '664 fails to disclose that the formula comprises a halomethyl group." Applicant then goes on to argue that Examiner has not established a *prima facie* case of obviousness, citing the three-pronged test in *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

12. First, Examiner previously directed Applicant to the motivation statement expressly contained within the reference at lines 25-26 of page 5: "A preferred alkyl moiety is an ethyl or especially a methyl group." Second, a skilled chemist would reasonably expect success in

Application/Control Number: 10/550,571

Art Unit: 1624

simply modifying Blasco's ethyl to the claimed invention's methyl. Third, the express teaching cited above is not found in Applicant's disclosure, but in the reference and suggests all of the claim limitations.

13. Because Examiner does not find any of Applicant's arguments persuasive, his previous provisional rejection of claims 2-4 under 35 U.S.C. § 103(a) as being unpatentable over Blasco et al., U.S. Application Number 10/474,460 is made FINAL.

Double Patenting

14. Examiner previously rejected claims 1-5 and 7-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Pees et al., U.S. 6,559,151.

15. Applicant argues that: "It is well settled that a genus does not always *anticipate* a claim to a species within the genus." (Emphasis added). It is important to note that this rejection is *not* an anticipation rejection, had Examiner found an exemplified compound in Pees et al., '151, then Examiner would have made a 102 rejection instead of the present obviousness-type double patenting rejection.

16. Applicant then goes on to argue that: "Pees '151 discloses preferred embodiments, none of which lists alkynyl as a preferred R¹ or R² group." This is simply not true because Pees et al., '151 expressly suggests alkynyl in claim 1: "R¹ or R² independently denote ... C₂-C₁₀-alkynyl."

17. Because Examiner does not find any of Applicant's arguments persuasive, his previous rejection of claims 1-5 and 7-8 over Pees et al., U.S. 6,559,151 is made FINAL.

18. Examiner previously provisionally rejected claims 1-5 and 7-8 under the judicially created doctrine of double patenting as being unpatentable over claims 1-2 and 6-8 of copending

Application/Control Number: 10/550,571

Art Unit: 1624

U.S. Patent Application No. 10/513,030. Examiner acknowledges that U.S. Patent Application No. 10/513,030 has matured in to U.S. Patent No. 7,094,894.

19. Applicant argues that: "It is well settled that a genus does not always *anticipate* a claim to a species within the genus." (Emphasis added). It is important to note that this rejection is *not* an anticipation rejection, had Examiner found an exemplified compound in Blasco et al., '894, then Examiner would have made a 102 rejection instead of the present obviousness-type double patenting rejection.

20. Applicant then goes on to argue that: "Blasco '894 discloses preferred embodiments, none of which lists alkynyl as a preferred R¹ or R² group." This is simply not true because Blasco et al., '894 expressly suggests alkynyl in column 1, line 31: "R¹, R² are, independently of one another ... C₂-C₁₀-alkynyl."

21. Because Examiner does not find any of Applicant's arguments persuasive, his previous rejection of claims 1-5 and 7-8 under the judicially created doctrine of double patenting is made FINAL.

22. Examiner previously provisionally rejected claims 1-5 and 7-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 9 and 10 of copending Application No. 10/523,719. Examiner withdraws this rejection because copending Application No. 10/523,719 is drawn to different art altogether.

23. Examiner previously provisionally rejected claims 1-5 and 7-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12-13, 18 and 19 of copending Application No. 10/508,409. Examiner acknowledges that Application No. 10/508,409 has matured in to U.S. Patent No. 7,148,227.

Application/Control Number: 10/550,571

Art Unit: 1624

24. Applicant argues that, "a genus does not always *anticipate* a claim to a species within the genus." (Emphasis added). It is important to note that this rejection is *not* an anticipation rejection, had Examiner found an exemplified compound in Blasco et al., '227, then Examiner would have made a 102 rejection instead of the present obviousness-type double patenting rejection.

25. Because Examiner does not find Applicant's argument persuasive, his previous rejection of claims 1-5 and 7-8 under 35 U.S.C. § 103(a) as being unpatentable over Blasco et al., '227 is made FINAL.

26. Examiner previously provisionally rejected claims 1-5 and 7-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/483,597. Because the instant application was filed later than the reference, a Terminal Disclaimer will be needed before the claims in this case issue.

27. Because Applicant did not raise any substantive arguments, Examiner's previous rejection of claims 1-5 and 7-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/483,597 is made FINAL.

28. Examiner previously provisionally rejected claims 1-5 and 7-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10/483,599. Examiner acknowledges that Application No. 10/483,599 matured in to U.S. Patent No. 7,083,047.

29. Applicant argues that, "a genus does not always *anticipate* a claim to a species within the genus." (Emphasis added). It is important to note that this rejection is *not* an anticipation

Art Unit: 1624

rejection, had Examiner found an exemplified compound in Blasco et al., '047, then Examiner would have made a 102 rejection instead of the present obviousness-type double patenting rejection.

30. Because Examiner does not find Applicant's argument persuasive, his previous rejection of claims 1-5 and 7-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Blasco et al., '047 is made FINAL.

31. Examiner previously provisionally rejected claims 1-5 and 7-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/483,600. Because the instant application was filed later than the reference, a Terminal Disclaimer will be needed before the claims in this case issue.

32. Because Applicant did not raise any substantive arguments, Examiner's previous rejection of claims 1-5 and 7-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/483,600 is made FINAL.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Application/Control Number: 10/550,571

Art Unit: 1624

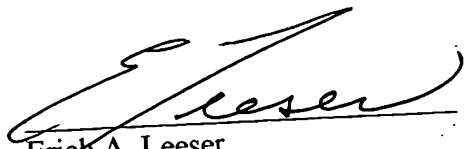
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion


Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Erich A. Leeser whose telephone number is 571-272-9932. The Examiner can normally be reached Monday through Friday from 8:30 to 6:00 EST.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax number for the organization where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Erich A. Leeser
Assistant Examiner



Zachary C. Tucker
Primary Examiner